



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Andreas STEINMEYER et al.

Serial No.: 09/509,934

Group Art Unit: 1616

Filed: May 3, 2000

Examiner: S. Qazi

For: New Vitamin D Derivatives With Cyclopropyl Rings In The Side Chains, Process And Intermediate Products For Their Production And Their Use For The Production Of Pharmaceutical Agents

**INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR §§ 1.56, 1.97 and 1.98**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This information disclosure statement is made in accordance with 37 C.F.R. §§ 1.56, 1.97 and 1.98 as follows:

**Timing and Fees**

- ☐ Under 37 C.F.R. § 1.97(b), no fee or statement is required for filing this information disclosure statement is filed:
- ☐ within three months of the filing date of a national application other than a CPA under § 1.53(d);
  - ☐ within three months of the actual filing date of the national phase of a PCT application; OR
  - ☐ before the mailing of a first substantive office action (including after filing of an RCE).
- ☐ Under 37 C.F.R. § 1.97(c), this information disclosure statement is filed after the periods specified in 37 C.F.R. § 1.97(b), but before the mailing date of:
- ☒ a final rejection under 37 C.F.R. 1.113;
  - ☐ termination of prosecution, e.g. Ex Parte Quayle, M.P.E.P § 609(B)(2); OR

☐ a notice of allowance under 37 C.F.R. § 1.311; and

is accompanied by:

☐ the statement as specified in 37 C.F.R. § 1.97(e) set out below; OR

☒ a check covering the fee of \$180.00 under 37 C.F.R. § 1.17(p).

☐ Under 37 C.F.R. § 1.97(d), this information disclosure statement is filed after the mailing date of the following actions which have not been withdrawn:

☐ a final action under 37 C.F.R. § 1.113;

☐ termination of prosecution, e.g. Ex Parte Quayle, M.P.E.P § 609(B)(2);  
OR

☐ a notice of allowance under 37 C.F.R. § 1.311;

AND is filed on or before payment of the issue fee; AND is accompanied by:

☐ the statement as specified in 37 C.F.R. § 1.97(e) as set forth below, and the fee of \$180.00 under 37 C.F.R. § 1.17(p).

Statements Under 37 C.F.R. 1.97(e)

☐ Each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application having a mailing date not more than three months prior to the filing date of this information disclosure statement; or

☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and to the knowledge of the undersigned attorney after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing date of the information disclosure statement.

Cited Materials

☐ Copies of materials listed but not attached were cited in benefit (35 U.S.C. § 120) ancestor application Serial No. \_\_\_\_\_, on Form 892 by the Examiner and/or Form 1449 by the applicant; see 37 C.F.R. § 1.98(d).

☐ Copies of materials listed but not attached were cited in an international search report dated \_\_\_\_\_.

- ☒ Copies of the materials listed are attached (except for the foregoing).

Non-English Language References

- ☐ An English-language search report or equivalent paper from a foreign patent office is provided indicating the relevance of the cited reference(s).
- ☐ A foreign-language search report from a foreign patent office is provided, and pertinent parts are translated substantively below:

X = document of particular relevance when it is taken alone  
Y = document of particular relevance when it is combined with another such document  
A = document defining the general state of the art  
O = non-written disclosure  
P = intercalated document  
T = document cited to understand the theory or principle underlying the invention  
E = patent document which has the benefit of a date earlier than the filing date and which was published only on or after this filing date  
D = cited in the application  
L = cited for another reason  
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- ☐ Translation of other relevant information on foreign search report

Other Information

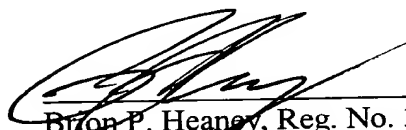
DE 196 19 036 corresponds to US patent application Serial Nos. 09/180,018, 09/695,137, and 09/695,091. DE 42 34 382 corresponds to US 5,583,125. DE 42 21 961 corresponds to US 5,663,157. DE 42 20 757 corresponds to US 5,700,791 and US 5,585,368. WO 97/00242 corresponds to US patent application Serial Nos. 08/981,819 (US 6,372,731) and 09/738,286 (US 6,376,480).

Payment of Fees Due (If Any):

- ☒ A check for \$180.00 covering the fee identified above is attached.
- ☐ Please charge to Deposit Account No. 13-3402 \$\_\_\_\_\_ for the fee identified above.

☒ The Commissioner is hereby authorized to charge or credit any overpayment to Deposit Account #13-3402, two copies of this paper are attached for this purpose.

Respectfully submitted,



Brian P. Heaney, Reg. No. 32,542  
Attorney for Applicants

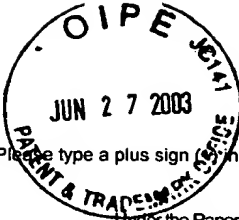
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Attorney Docket No.: SCH-1747

Date: June 27, 2003

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## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet

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of

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Complete if Known

Application Number	09/509,934
Filing Date	May 3, 2000
First Named Inventor	Andreas STEINMEYER
Group Art Unit	1616
Examiner Name	S. Qazi
Attorney Docket Number	SCH-1747

### U.S. PATENT DOCUMENTS

Examiner Initials *	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
		Number	Kind Code <sup>2</sup> (if known)		
	1	5,190,935		Binderup et al.	03/02/1993
	2	5,585,368		Steinmeyer et al.	12/17/1996
	3	5,663,157		Steinmeyer et al.	09/02/1997
	4	5,583,125		Steinmeyer et al.	12/10/1996
	5	6,376,480		Kirsch et al.	04/23/2002
	6	6,372,731		Kirsch et al.	04/16/2002
	7	5,700,791		Steinmeyer et al.	12/23/1997

### FOREIGN PATENT DOCUMENTS

Examiner Initials *	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	8	WO	97/00242	A1	Kirsch et al.	01/03/1997		Abs.
	9	WO	94/14453	A1	Serup et al.	07/07/1994		
	10	EP	0 742 203	B1	Kutner et al.	09/29/1999		
	11	DE	196 19 036	A1	Steinmeyer et al.	11/13/1997		Abs.
	12	DE	42 20 757	A1	Steinmeyer et al.	01/05/1994		Abs.
	13	DE	42 21 961	A1	Steinmeyer et al.	01/05/1994		Abs.
	14	DE	44 45 045	A1	Steinmeyer et al.	06/13/1996		Abs.
	15	DE	42 34 382	A1	Kirsch et al.	04/07/1994		Abs.

Examiner  
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Date  
Considered

\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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